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1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

Claim Rejections - 35 USC § 112

2. Claims 1-26 and 28-44 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. This holding is maintained from paragraph 4 of action mailed Dec 5, 2008 incorporated herein. Paragraph 5 of same action is reiterated next.

3. Claims 1-26 and 28-44 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for wired communication of encryption code to player device, does not reasonably provide enablement for wireless communication of encryption code to player device and remarks filed Oct 5, 2009 on page 9 states in part 'transmitting' has been replaced by 'communicating' to make clear that the communication of the encryption code is not intended to be limited to wireless transmission. Thus, communication includes wireless; however, as previously noted the specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make/use the invention commensurate in scope with these claims. Essentially, the specification states in part in paragraphs 39-41 of PG PUB 20050070358 that the wireless gaming device may store an encryption key, the encryption key 32 is preferably stored in EEPROM 34 and that the encryption key 32 stored in EEPROM 34 may be updated and changed for each player who receives wireless gaming device 20 *by directly connecting device 20 to encoding and decoding circuitry 82 in terminal 50 through port 84*. In so far as claimed communication includes wireless due to not precluding, the disclosure does not support wireless communication of encryption code prior to wager information being entered disclosed to provide public notice.

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4. Claims 1-26 and 28-44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Where the claimed communication includes wireless (*supra*), it is unclear what device wirelessly communicates an encryption code to the wireless gaming device prior to the wagering information being entered by the player (clm 1-20), communicating an encryption code to the wireless gaming device (clm 21-26), using an encryption code received by the wireless gaming device before the wireless gaming device prior to the entry of the wagering information (clm 28-43), and communicating an encryption code to the wireless device prior to the entry of wagering information by the player (clm 44) where the form of communication of the encryption code is wireless since the disclosure teaches that the encryption code is stored in the player device and can change the code by direct connection via port (paras 39-41 of PG PUB 20050070358) such that there is no wireless communicating of encryption code prior to wagering by player; however the breadth of claimed communication and receiving of encryption code includes wireless and there is no evidence that demonstrates such form of communication or receipt of code was disclosed in manner to put public in possession of what was invented regarding the form of communication being wireless since claims are not specified to preclude wireless. Claims regard wireless device communicating that is wireless.

Claim Interpretation

5. Claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure. However, examples of claim language, although not exhaustive, that may raise a question as to the limiting effect of the language in a claim are: (A) adapted to or adapted for

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clauses; (B) wherein clauses; and (C) whereby clauses. The determination of whether each of these clauses is a limitation in a claim depends on the specific facts of the case. In *Hoffer v. Microsoft Corp.*, 405 F.3d 1326, 1329, 74 USPQ2d 1481, 1483 (Fed. Cir. 2005), the court held that when a “whereby” clause states a condition that is material to patentability, it cannot be ignored in order to change the substance of the invention.” *Id.* However, the court noted (quoting *Minton v. Nat’l Ass’n of Securities Dealers, Inc.*, 336 F.3d 1373, 1381, 67 USPQ2d 1614, 1620 (Fed. Cir. 2003)) that a “whereby clause in a method claim is not given weight when it simply expresses the intended result of a process step positively recited.”” *Id.* In this case, the ‘wherein’ clauses have been treated as if the particular limitation in each respective clause states a condition that is material to patentability; but, such narrow interpretation is generous since each of the claimed functions is as would be interpreted by an artisan not material to patentability.

6. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In *re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board’s finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also *In re Swinehart*, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). “[A]pparatus claims cover what a device is, not what a device does.” *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original). In this case, the claimed function does not distinguish over structure of prior art performing same function for same purpose.

Claim Rejections - 35 USC § 102

7. Claims 1, 4-6, 8-12, 15, 17-18, 20-21, 23-24, 26, 38-41 and 44 are rejected under 35 U.S.C. 102(b) as being anticipated by Schneier (5871398). As best understood with broadest reasonable interpretation of claims, Schneier '398 discloses a system, wireless gaming device and method teaching claimed steps/features (abstract, 4:47-5:18, 23:8-27:40, figs. 1-13) including a wireless hand held gaming device (6:27-30, ref 20, HTV, PDA, cellular phone), comprising an id code identifying the wireless gaming device and uniquely associated with player and/or gaming device (4:47-5:18, 7:8-9, 19-21, 14:48-50, ref I, 116), entry apparatus (12:8-14, ref 86) configured to receive wagering information entered by a player as representing a wager request entered by a player to include command and data to form a bet comprising a string of characters (4:47-5:18, 6:7-31, 9:51-52, 10:9-10, 11:16-22, i.e. a purchase request for a number of games/tickets is wager request as a command to buy tickets/games), a transmitter configured to transmit a signal by radio frequency (11:1-12:53, figs 1-13, ref 113, 115) including both the player's wager information and the identification code in an encrypted form (abstract, 4:47-5:18, 6:13-15, 7:16-21, 7:46-8:67, 11:16-22, 12:20-13:34, figs. 1-13), a device configured to communicate an encryption code to the wireless gaming device prior to the wagering information being entered by the player (abstract, 4:47-5:18, 7:49-8:67, 12:20-13:34, figs. 1-13, ref 12, CMC), the wireless gaming device configured to encrypt the signal using the encryption code prior to the transmission of the signal including the player's wager information and the identification code (4:47-5:18, 6:13-15, 7:16-21, 7:46-8:67, 11:16-22, 12:20-13:34, figs. 1-13), wager amount register and account balance register (11:57-15:11, ref 154), a card reader/writer including smart card (13:5-34, ref 27, 28), an encryption key and a decryption key (7:49-8:67,

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12:20-13:34, figs. 1-13), a database (7:2-21, 11:16-15:11, fig 3, ref 16, 30), including storing in a chip or ROM an identifier corresponding to the identification code (abstract, 4:47-5:18, 7:8-9, 19-21, 14:48-50, ref I, 116) further comprising steps providing the wireless gaming device (4:47-5:18, 6:7-31, 7:2-8:67, 9:51-52, 10:9-10, 11:16-22) comprising an entry apparatus (ref 86) for entering wagering information (supra), a transmitter (13:41-57), an identification code stored on the wireless gaming device for identifying the wireless gaming device (abstract, 4:47-5:18, 7:8-9, 19-21, 14:48-50, ref I, 116), entering the wagering information into the entry apparatus (4:47-5:18, 6:7-31, 9:51-52, 10:9-10, 11:16-22, i.e. a purchase request for a number of games/tickets), communicating the identification code and the wagering information in an encrypted form (4:47-5:18, 6:13-15, 7:16-21, 7:46-8:67, 11:16-22, 12:20-13:34,), receiving and decrypting the transmitted identification code and wagering information (4:47-5:18, 6:13-15, 7:16-21, 7:46-8:67, 11:16-22, 12:20-13:34,), a display for displaying the wagering information (ref 84), receiving monetary tender (ref 73), establishing an account having account balance (ref 73), associating a wireless device having a stored identification code stored on the wireless gaming device (4:47-5:18, 7:8-9, 19-21, 14:48-50, ref I, 116), providing the player the wireless device (supra), receiving the identification code and wagering information (), registering the players wager in the database based on the wagering information and the identification code (), debiting the account balance (ref 154), determining if the player wager wins a prize, and crediting account balance (11:57-15:11, ref 154), receiving the wireless device from player and tendering money to player based on the account balance (11:57-15:11, 20:49-52, figs 1-13, ref 78, 154-155).

Claim Rejections - 35 USC § 103

8. Claim 7 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Schneier '398. Regarding claim 7, Schneier discloses claimed invention including entering character string for password and digits of games purchased in purchase request that includes hexadecimal (supra). Alternatively, Schneier does not clearly discuss string of characters such as selected wager elements being hexadecimal digits. An inventor does not need to discuss in their specification that which is old or conventional and preferably omits from their disclosure that which is conventional. Such is the case with Schneier in that Schneier does not disclose hexadecimal digits since it is conventional at least due to program language read by wireless device compiler, i.e. processor, translates inputs and program to assembler language which is in hexadecimal digits that is further translated to binary code of machine language. As further evidence thereto under MPEP 2131.01, as previously requested by remarks, see evidence from Wikipedia that hexadecimal is used in computer science and programming. Alternatively, the form of characters being hexadecimal (0-9 and A-F), or base sixteen, fails to patentably distinguish over Schneier at least since it is notoriously well known for computer compiler or processor to translate program language to assembler language which uses hexadecimal digits prior to translating to binary or machine code in executing program. This is hornbook engineering or basic computer programming. Alternatively, in so far as Schneier lacks hexadecimal digits, as alleged by Applicant, the use of hexadecimal digits fails to critically distinguish over form of digits used by Schneier as same structure performing same function for same purpose in that the form of digits being hexadecimal fails to patentably distinguish over Schneier. Regarding claim 19, Schneier discloses claimed system including a

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memory storing identification code (sic) including ROM chip that by happenstance is an EPROM. An inventor does not need to discuss in their specification that which is old or conventional and preferably omits from their disclosure that which is conventional. Such is the case with Schneier in that Schneier does not state chip is EPROM; however, such chips being EPROM was conventional prior to invention. As evidence only, Bergeron (4764666) or Sarbin (5179517) each discloses a memory storing an identification code where the memory is EPROM for ease of reprogramming data stored in ROM. Schneier also uses smart card (sic). In the alternative, it would have been obvious to an artisan at a time prior to the invention to apply EPROM as known memory device to Schneier to permit ease of reprogramming data stored in ROM. The form of memory being EPROM does not critically distinguish over memory of Schneier as same structure [memory] performing same function [storing] for same purpose.

9. Claims 13, 16 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schneier in view of Franchi (5770533). Schneier discloses claimed features of invention (sic) including a display and remote communication except LCD (claim 13) and infrared signals (claim 16, 25). However, in a related reference, Franchi (15:26-16:22) discloses a wireless handheld gaming device comprising an LCD screen and infrared signals. However, an LCD for displaying and infrared signals for communicating is each notoriously well known in gaming. Infrared signals permit wireless remote direct communication; while, LCD permits easy to read display. Franchi is analogous art at least due to either being in the field of applicant's endeavor or, is reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). The level of ordinary skill in the art is as shown

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by the references. In consideration of US Supreme Court decision in KSR, that 'known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations are predictable to one of ordinary skill in the art', it would have been obvious to an artisan at a time prior to the invention to apply LCD and infrared signals as notoriously well known or as taught by Franchi to improve the system, method and device of Schneier for the predictable result to provide an easy to read display and to provide remote direct communication. Additional evidence under MPEP 2131.01, as requested by remark on page 17, as reported by Wikipedia the initial PDAs used IR for remote communication due to IR technology being less costly. Schneier teaches use of PDAs [and cellular phone] as its handheld portable wireless wagering device.

10. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schneier in view of Pease (5326014). Schneier discloses claimed features (supra) but lacks disclosing bicolor light emitting diode. Use of LED as an indicator is well known in gaming. Pease disclose use of tricolor LED as an indicator (9:55-10:55). It is known in gaming to provide indication of either game state or device operability state. Pease is analogous art for either being in the field of applicant's endeavor or, being reasonably pertinent to the particular problem with which the applicant was concerned. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992).

The level of ordinary skill in the art is as shown by the references. In consideration of US Supreme Court decision in KSR, that 'known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations are predictable to one of ordinary skill in the art', it would have been obvious to an artisan at a time prior to the invention to apply bicolor LED as taught by

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Pease to improve the system, method and device of Schneier for the predictable result of providing an indicator of operability or game state so as to alert user. Although, Pease provides use of LED to indicate another facet of game play, this does not teach away from claimed invention. It is known in gaming to provide indication of either game state or device operability state. The claimed function 'to indicate separately that the wagering information has been entered and wagering information has been transmitted' is a recitation pertaining to operational status indicator of device. Pease teaches providing operational status as an indicator to user. Thus, the standard of patentability remains as what the prior art taken as a whole would have suggested to an artisan at a time prior to the invention. In this instance, Schneier in view of Pease taken as a whole at a time prior to the invention suggests to an artisan a wireless gaming device including a bicolored LED to provide an indication of either game state or operability status.

11. Claims 2, 22, 28-34 and 42-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schneier in view of Woodfield (EP 0649102). Schneier discloses claimed system, method and device (supra) including encryption and decryption of transmitted signals except periodically polls the wireless gaming device to determine whether the player has entered wagering information to be transmitted to the receiver (claim 2), periodically polling the wireless gaming device to determine whether the player has entered wagering information (claim 22), the transmitter transmitting the signal when the receiver polls the wireless gaming device to determine that the wagering information has entered (claim 28) and the wireless gaming device is periodically polled by the receiver (claim 29). Woodfield discloses system, device and method for transmitting wagering information while commanding placing of bets (4:4-15:24, figs. 1-4) comprising a wireless gaming device that includes an identification code (7:15-16), entry

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apparatus (6:6-18, refs. 15-16), and transmitter (18, 9), a receiver (4, 7, 8, 27) for receiving identification code and wagering information (15:16-24), the receiver polling the wireless gaming device (7:30-8:5, 15:16-24) to determine whether the player has entered wagering data to be transmitted. Woodfield teaches claimed polling by a receiver (7:15-8:5, 15:16-24) so as to conserve power (7:30-43) to include periodically polls the wireless gaming device to determine whether the player has entered wagering information to be transmitted to the receiver (7:15-8:5, 15:16-24) periodically polling the wireless gaming device to determine whether the player has entered wagering information (sic), the transmitter transmitting the signal when the receiver polls the wireless gaming device to determine that the wagering information has entered (sic) and the wireless gaming device is periodically polled by the receiver (supra) such that a receiver periodically polls the wireless gaming device to determine if new data has been entered where data is environment of use such as wagering and Woodfield clearly states use of wireless device to place bets on sporting events, i.e. wagering. Woodfield is analogous art for either being in the field of applicant's endeavor or, being reasonably pertinent to the particular problem with which the applicant was concerned. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). The level of ordinary skill in the art is as shown by the references. In consideration of US Supreme Court decision in *KSR*, that 'known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations are predictable to one of ordinary skill in the art', it would have been obvious to an artisan at a time prior to the invention to apply periodically polls the wireless gaming device to determine whether the player has entered wagering information to be transmitted to the receiver, periodically polling the wireless gaming device to determine whether

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the player has entered wagering information, the transmitter transmitting the signal when the receiver polls the wireless gaming device to determine that the wagering information has entered and the wireless gaming device is periodically polled by the receiver as taught by Woodfield to improve the system, method and device of Schneier for the predictable result to conserve power. The standard of patentability is what the prior art taken as a whole suggests to an artisan at a time prior to the invention. In this case, when Schneier in view of Woodfield is taken as a whole at a time prior to the invention, the combination suggests to an artisan a wireless gaming system, method or device comprising a wireless gaming device that includes periodically polls the wireless gaming device to determine whether the player has entered wagering information to be transmitted to the receiver, periodically polling the wireless gaming device to determine whether the player has entered wagering information, the transmitter transmitting the signal when the receiver polls the wireless gaming device to determine that the wagering information has entered and the wireless gaming device is periodically polled by the receiver so as to conserve power.

12. Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schneier in view of Woodfield as applied to claim 28 above, and further in view of Franchi. Schneier in view of Woodfield discloses/suggests claimed wireless device (supra) except infrared signals. As in evidence above reiterated herein, Franchi (15:26-16:22) discloses a wireless handheld gaming device comprising infrared signals. However, infrared signals for communicating are notoriously well-known in gaming. Infrared signals permit wireless direct communication. Franchi is analogous art at least due to either being in the field of applicant's endeavor or, is reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977

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F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). The level of skill in the art is as shown by the references. In consideration of decision in KSR, that 'known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations are predictable to one of ordinary skill in the art', it would have been obvious to an artisan at a time prior to the invention to apply LCD and infrared signals as notoriously well known or as taught by Franchi to improve the system, method and device of Schneier in view of Woodfield for the predictable result to provide an easy to read display and to provide wireless direct communication. Additional evidence under MPEP 2131.01, as requested by remark on page 17, as reported by Wikipedia the initial PDAs used IR for remote communication due to IR technology being less costly. Schneier teaches use of PDAs and cellular phones as its handheld portable wagering device.

13. Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schneier in view of Jacobson (5785592). Schneier teaches claimed wireless device (supra) but lacks a security tag, sensing apparatus as claimed. Jacobsen discloses a wireless handheld game device that is used for placing wagers teaching a security tag affixed to or included as part of wireless terminal and a sensing apparatus which activates an alarm when the security tag is passed through the sensing apparatus for increased security to ensure device does not leave gaming hall. Jacobsen is analogous prior art since Jacobsen is either in the field of applicant's endeavor of wireless wagering handheld device (fig 1-4, ref 20, 96 and description thereof) or, at least is reasonably pertinent to the particular problem with which the applicant was concerned of improved security by adding electronic tag to device/terminal to alert security if wireless wagering device passes through portal (fig. 4), so as to be relied upon as a basis for rejection of the claimed invention.

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See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). The level of ordinary skill is as shown by references. In consideration of decision in KSR, that 'known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations are predictable to one of ordinary skill in the art', it would have been obvious to an artisan at a time prior to the invention to apply a security tag affixed to or included as part of wireless terminal and a sensing apparatus which activates an alarm when the security tag is passed through the sensing apparatus as taught by Jacobsen to improve the system, method and device of Schneier for increased security to alert security whenever device is in process of leaving gaming hall.

14. Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schneier in view of Woodfield as applied to claim 28 above, and further in view of Jacobson (5785592).

Schneier in view of Woodfield suggests claimed wireless device to an artisan (*supra*) but lacks a security tag, sensing apparatus as claimed. Jacobsen discloses a wireless handheld game device that is used for placing wagers teaching a security tag affixed to or included as part of wireless terminal and a sensing apparatus which activates an alarm when the security tag is passed through the sensing apparatus for increased security to ensure terminal/device does not leave gaming hall. Jacobsen is analogous prior art since Jacobsen is either in the field of applicant's endeavor of wireless wagering handheld device (fig 1-4, ref 20, 96 and description thereof) or, at least is reasonably pertinent to the particular problem with which the applicant was concerned of improved security by adding electronic tag to device/terminal to alert security if wireless wagering device passes through portal (fig. 4), so as to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992).

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The level of ordinary skill is as shown by references. In consideration of decision in KSR, that 'known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations are predictable to one of ordinary skill in the art', it would have been obvious to an artisan at a time prior to the invention to apply a security tag affixed to or included as part of wireless terminal and a sensing apparatus which activates an alarm when the security tag is passed through the sensing apparatus as taught by Jacobsen to improve the system, method and device of Schneier in view of Woodfield for increased security to alert security whenever device is in process of leaving gaming hall.

Response to Arguments

15. Applicant's arguments with respect to claims 1-2, 4-26 and 28-44 have been considered but are moot in view of the new ground(s) of rejection. The Office does not agree with interpretation of Walker '950; however, Schneier appears a better reference to pending claims.

16. Applicant's arguments filed May 24, 2010 have been fully considered but they are not persuasive. The combined remarks rec'd Oct 5, 2009, pages 8-9 therein and pages 2-3 of those rec'd in May remain unpersuasive where communicating includes wireless since there is only two forms of communication wired or wireless and remarks on page 9 states not intended to be limited to wireless but fails to preclude wireless by claiming wired communication. Also, the remarks have never addressed the entire issue of holding regarding the claim language of timing and wireless in so far as communication includes wireless due to not specifically precluding it.

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Conclusion

17. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Sager whose telephone number is 571-272-4454. The examiner can normally be reached on T-F, 0700-1730 hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 571-272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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/M. Sager/
Primary Examiner, Art Unit 3714